

REMARKS/ARGUMENTS

Amendments

The claims are unmodified in the amendment. No claims have been amended, cancelled or added. Therefore, claims 1-10, 12-18 and 20-22 remain present for examination. No new matter is added by these amendments. Applicant respectfully requests reconsideration of this application as amended.

35 U.S.C. §112 Rejection

The Office Action has rejected claims 1, 12 and 20 on the basis that there is insufficient antecedent basis for the limitation "temporary stored value fund" in the claim.

Applicants wish to draw the Examiner's attention to paragraphs [78], [88], and [95] for description of stored value accounts/funds. Applicants believe that there is proper antecedent basis for this limitation and respectfully request the Examiner to withdraw this rejection.

35 U.S.C. §103 Rejection, Rosen in view of Kolling et al. and Official Notice

The Office Action has rejected claims 1-10, 12-18 and 20-22 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,557,518 to Rosen (hereinafter "Rosen") in view of U.S. Patent No. 5,920,847 to Kolling et al. (hereinafter "Kolling") and Official Notice. The patent office (the "Office") is charged with putting forth a *prima facie* showing of obviousness. Applicants believe a *prima facie* case of obviousness has not been properly set forth in the final Office Action or, in the alternative, the current amendments render the present rejections moot. The basic test for obviousness is excerpted below:

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure.” MPEP §2143, Original Eighth Edition, August, 2001, Latest Revision May 2004.

Applicants believe the rejection has flaws with all three prongs of the above test for establishing a *prima facie* case of obviousness as outlined below.

Teachings Missing from the Cited References

With regard to the third prong of the test, Applicants believe Rosen and Kolling do not, either alone or in combination, teach or suggest the invention in the claims. More specifically, (1) Neither Rosen nor Kolling provides a third account, where the third account is not associated with the either the first party or the second party, is a temporary stored value fund, and receives credits from the first account and debits from the second account; (2) Rosen does not imply that there is notification of a first transfer clearing by a process that can initiate the second transfer; and (2) Kolling does not teach or suggest doing a second transfer before determining that the first one clears. For least these reasons, Applicants respectfully request for reconsideration of the rejection to the claims.

The Examiner's Official Notice states that the following information was well known to the ordinary practitioner of the art at the time of Applicant's invention: 1) the sending and receiving of credits and debits electronically between accounts; b) that the first party on whose behalf the bill payer/third party is transferring funds to the second party rarely if ever receives confirmation information between the bill pay service transmits the funds to the biller and the funds clear, which clear the same day or within a few days in the case of checks; and c) that it would have been an obvious option for the third party to transmit clearance information

about the first party's funds transfer to the third part *sic* to positively verify that the first party's transfer was completed in the funds transfer system.

First Missing Limitation: The Third Account

All claims require provision of a third account. The third account is not associated with either the first party or the second party, is a temporary stored value fund, and receives credits from the first account and debits from the second account. Neither Rosen nor Kolling provide a similar third account. Examiner fails to mention the third account in the Official Notice.

Indeed, Examiner admits that Rosen does not teach a third account. *See* Office Action. p. 3. Rosen provides two (2) money modules that store and transfer money. See Rosen, Fig. 1, col. 4, lines 14-16 ("*The money modules contemplated herein are tamper-proof devices capable of storing and transferring electronic money.*") (*emphasis added*). Rosen does not provide a single account. Further, The money modules are associated with a party. See Rosen, col. 4, lines 25-27 ("Conceptually, a trusted agent is a surrogate actor for an entity who wants to transact remotely (electronically) in a secure way."). As such, Rosen simply does not describe a third account.

Kolling does not overcome the deficiencies found in Rosen. Kolling provides several accounts related to the parties. *See* Kolling, Fig. 6, col. 18, line 63 -- col. 19, line 5 ("Settlement Bank 128 is shown with four accounts: a settlement account 154 for Bank C, a settlement account 155 for Bank B, a settlement account 152 for the payment network, and a settlement account 156 representing settlement accounts for other banks besides Bank C and Bank B. Settlement bank 128 is shown coupled to settlement subsystem 104 to accept transfer orders 130, which would then result in transfers of funds between accounts 152, 154, 155 and other accounts for other banks 156."). Kolling does not describe a single third account not associated with the parties. As such, Kolling also does not describe the third account as claimed.

Examiner does not state that Kolling teaches a third account. *See* Office Action at p. 3. As such, Examiner seems to admit that the teaching of Kolling is also deficient in teaching a third account. Indeed, the section cited by the Examiner ("In other cases, the payment is an

electronic transfer where the consumer's account information is included with the transfer or provided in a list of payments from multiple consumers provided by the service bureau to the biller.” *Kolling*, col. 2, lines 26-29) makes not mention of a third account that is a stored value fund and unassociated with either of the parties.

Second Missing Limitation: First Transfer Clearance Notification

All claims require notification by the third account that the first transfer has cleared. This limitation is not expressed in *Rosen*, and the Office Action further illustrates this assertion. The Examiner has previously stated that the first party receives confirmation only of when the bill is paid. This paid bill confirmation is different from the confirmation that the first transfer is completed. A bill is paid in the second transfer and not the first transfer. Indeed, the Examiner has even stated that confirmation of transfers to the biller are rare or never happen. As such, the Examiner appears to recognize that neither *Rosen* nor *Kolling* include receiving notification, from the third account, that the first transfer has cleared.

Examiner has tried to broad brush the differences in the prior art and the present claims by taking Official Notice of some important features of the claims. Applicants believe that the Examiner has improperly used Official Notice. “Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970).” MPEP § 2144.03. Applicants assert that it was not well known to transfer money from a third, stored value account, to a second account before receiving clearance that funds have been placed into the stored value account from the first account. This type of transaction was not necessarily well-known in the art at the time of filing the present application. Indeed, the Examiner states that “often payees don’t even receive an explicit funds clearance notification. Office Action at p. 4. As such, the Examiner should provide documentary evidence that this type of transaction occurred.

Third Missing Limitation: Second Transfer Before Notification

All claims require initiation of the second transfer before receiving notification that the first transfer has cleared. The Office Action cites the Background Section of Kolling for this proposition, specifically, column 2, lines 26-29. Applicant disagrees. Kolling doesn't mention receiving notification of clearance between a series of transfers. Indeed, Kolling states that funds are secured before the second transfer. Kolling, column 7, lines 53-59 ("Assuming that service bureau S has correctly identified and confirmed that biller B is a biller which consumer C desired to pay with bill pay order 56, then service bureau S passes the funds to biller B as biller payment 60 (arrow 12) *after securing funds to cover the remittance.*") (*emphasis added*). Kolling simply does not describe initiating the second transfer occurs before receiving notification that the first transfer has cleared.

The Examiner again attempts to gloss over this requirement using Official Notice. Applicants assert that it was not well known to transfer money from a third, stored value account, to a second account before receiving clearance that funds have been placed into the stored value account from the first account. This type of transaction was not necessarily well-known in the art at the time of filing the present application.

Motivation to Combine

Motive to Combine: Specific Mix-and-Match Motives Lacking

Applicants believe motivation for the specific combination of elements in the cited references is lacking. The Office cites a motivation to make payments as the reason to pick and choose elements from two references. Both references achieve this goal in different ways. Accordingly, it is not clear how that motive would cause one of ordinary skill in the art to start substituting one system, or portions thereof, for another system. Both references achieve this goal on their own, so mixing-and-matching makes no sense. A motivation to make the specific substitutions set forth in the Office Action is respectfully requested.

Motive to Combine: Kolling Teaches Away from Combination

Applicants believe motivation for the specific combination of elements in the cited references fails because Kolling indicates that the cited examples are not suitable for electronic invoice payments. Kolling, column 10, lines 63-67. The claims state that this invention is "for transferring funds in an online transaction". One of ordinary skill in the art would be unlikely to combine a teaching from Kolling that cannot "accommodate electronic invoice presentments" as would be required in any "online transaction."

The Examiner is required to state a motivation as to why one of ordinary skill in the art could have combined the elements as claimed. See MPEP § 2143.01. Providing some general assertion of motivation does not provide a reasoning for why one skilled in the art would combine the stated claim elements.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,



Tadd F. Wilson
Reg. No. 54,544

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 303-571-4000
Fax: 415-576-0300
TFW:slb
61211726 v1